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JUL 16 2010

OFFICE OF PETITIONS

In re Application of :
Paulsson, et al. :
Application No. 10/019,067 : ON APPLICATION FOR
Filed: June 28, 2002 : PATENT TERM ADJUSTMENT
Attorney Docket No. **HLZ-001USRCE** :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.705(b)" filed March 26, 2010. Applicants submit that the patent term adjustment to be indicated on the patent is a minimum of one thousand, one hundred and sixty-four (1,164) days, not twenty-nine (29) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent. Applicants also include some disclosure, pursuant to applicants' duty of good faith and candor to the Office, that additional reduction to the patent term adjustment is warranted.

Relative to the any assertion that the Office will take in excess of 3 years of the filing date to issue this patent, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As

such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

the mailing of the Notice of Allowance is **zero (0) days**. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On December 29, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 29 days. On March 26, 2010, applicants submitted the instant comment. Applicants disclose that the reduction to the patent term adjustment for applicant delay should be increased by 76 days.

The record reveals that applicants should have been assessed a delay under 37 CFR 1.704(b)² for filing a reply in excess of the three month period from the March 1, 2002, mailing date of the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US). Thus, applicants failed to engage in reasonable efforts to conclude processing or examination of this application. Accordingly, the period of adjustment set forth in § 1.703 should have been reduced under 37 CFR 1.704(b) by 27 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), June 2, 2002, and ending on the date the response was filed, June 28, 2002. A period of reduction of 27 days will be entered.

² 37 CFR 1.704(b) states:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

Further review of the application history reveals that on February 6, 2006, a restriction/election requirement was mailed. Applicants filed a response thereto on August 7, 2006. On August 25, 2006, a Notice of Incomplete Reply was mailed indicating that the response of February 6, 2006, was incomplete. On September 25, 2006, applicants filed a response to correct the omission in the reply filed on August 7, 2006.

37 CFR 1.704(c)(7) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(7) Submission of a reply having an omission (§1.35(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date the reply or other paper correcting the omission was filed.

It is undisputed that the response filed August 7, 2006, contained an omission and that a response correcting the omission was not filed until September 25, 2006. Accordingly, pursuant to 37 CFR 1.704(c)(7), a period of reduction of forty-nine (49) days will be entered, encompassing the period beginning on the day after the date the reply having an omission was filed, August 8, 2006, and ending on the date the reply correcting the omission was filed, September 25, 2006.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is 0 days.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this specific matter should be directed to the undersigned at (571) 272-3222.

A handwritten signature in black ink, appearing to read 'Kenya A. McLaughlin', is written over the typed name.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Monday
Date: 7/12/2010

PALM INTRANET

Time: 14:33:04

PTA Calculations for Application: 10/019067

Application Filing Date:	06/28/2002	PTO Delay (PTO):	609
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	580
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-76		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
111	07/12/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		49	
110	07/12/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		27	
97	12/29/2009	MAIL NOTICE OF ALLOWANCE			
96	12/22/2009	ISSUE REVISION COMPLETED			
95	12/22/2009	DOCUMENT VERIFICATION			
94	12/23/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
93	12/21/2009	EXAMINER'S AMENDMENT COMMUNICATION			
92	12/21/2009	NOTICE OF ALLOWABILITY			
91	12/14/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
84	12/08/2009	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
83	12/08/2009	NOTICE OF APPEAL FILED			
82	12/14/2009	DATE FORWARDED TO EXAMINER			
81	12/08/2009	AMENDMENT AFTER FINAL REJECTION		89	79
80	12/08/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
79	06/10/2009	MAIL FINAL REJECTION (PTOL - 326)			
78	06/08/2009	FINAL REJECTION			
73	04/06/2009	DATE FORWARDED TO EXAMINER			
72	03/17/2009	RESPONSE AFTER NON-FINAL ACTION		90	70
71	03/17/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
70	09/17/2008	MAIL NON-FINAL REJECTION			
69	09/15/2008	NON-FINAL REJECTION			
68	08/22/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			

63	08/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	59
62	09/10/2008	DATE FORWARDED TO EXAMINER			
61	08/22/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
60	09/10/2008	DATE FORWARDED TO EXAMINER			
59	08/22/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
58	09/10/2008	DISPOSAL FOR A RCE / CPA / R129			
57	08/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
56	08/22/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
55	02/28/2008	MAIL ADVISORY ACTION (PTOL - 303)			
54	02/06/2008	ADVISORY ACTION (PTOL-303)			
53	02/05/2008	DATE FORWARDED TO EXAMINER			
52	01/23/2008	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
51	01/23/2008	NOTICE OF APPEAL FILED		91	48
50	01/23/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
49	09/05/2007	CORRESPONDENCE ADDRESS CHANGE			
48	07/24/2007	MAIL FINAL REJECTION (PTOL - 326)			
47	07/18/2007	FINAL REJECTION			
44	05/19/2007	DATE FORWARDED TO EXAMINER			
43	05/04/2007	RESPONSE AFTER NON-FINAL ACTION		87	41
42	05/04/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
41	11/06/2006	MAIL NON-FINAL REJECTION			
40	10/30/2006	NON-FINAL REJECTION			
38	11/19/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
37	12/05/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
36	10/04/2006	DATE FORWARDED TO EXAMINER			
35	09/25/2006	RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES			
34	10/04/2006	ERROR(S) IN CRF CORRECTED BY STIC			
33	08/25/2006	MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED)			
32	08/21/2006	CRF DISKETTE UNREADABLE / DID NOT			

		COMPLY / REQUIRED BUT NOT SUBMITTED			
31	08/10/2006	MISCELLANEOUS INCOMING LETTER			
30	08/14/2006	DATE FORWARDED TO EXAMINER			
29	08/07/2006	RESPONSE TO ELECTION / RESTRICTION FILED		93	26
28	08/07/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	08/14/2006	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
26	02/06/2006	MAIL RESTRICTION REQUIREMENT			
25	02/05/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
24.7	12/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		38	22
24	12/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	12/20/2005	DATE FORWARDED TO EXAMINER			
22	10/28/2005	RESPONSE TO ELECTION / RESTRICTION FILED		92	19
20	10/28/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
19	04/28/2005	MAIL RESTRICTION REQUIREMENT	609		-1
18	04/27/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
17.7	11/19/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	11/19/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	11/19/2003	PRELIMINARY AMENDMENT			
15	12/19/2003	CORRESPONDENCE ADDRESS CHANGE			
14	12/16/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
12	12/04/2003	IFW AMENDED CASE PROCESSING COMPLETE			
10	11/19/2003	PRELIMINARY AMENDMENT			
8	10/30/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	09/16/2002	APPLICATION DISPATCHED FROM OIPE			
6	09/05/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
5	08/28/2002	NOTICE OF DO/EO ACCEPTANCE MAILED			
4	06/28/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
3	06/28/2002	ADDITIONAL APPLICATION FILING FEES			

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to [OASIS](#) | [Home page](#)